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REMARKS

This responds to the Office Action dated September 23, 2003.

Claims 1-5, 7-9 and 11-18, and 20-22 are pending in the application. All of the claims are rejected on a combination of references as being unpatentable over prior art, under 35 U.S.C.

103(a).

Claims 6 and 10 were cancelled by previous amendment. Claims 19 and 23 are cancelled by this amendment.

The independent claims have been amended.

Claim Rejections – 35 U.S.C. § 112

Claims 1-5, 7 and 8 were rejected under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

These claims have been amended. Claim 1 has been amended to avoid the use of “said step” in line 9 and “said pair of parallel spacer arms” in line 18.

Claim 2 has been amended to avoid the use of “the front of the side rails” in lines 8 and 9.

The applicant has adopted the suggestions made by the Examiner in claims 1, 7, 8 and 15.

It is submitted that the claims of the application should now comply fully with 35 U.S.C.

112.

Claim Rejections – 35 U.S.C. § 103

Claims 1-5, 7, 8, and 15-22 were rejected under § 103(a) as being unpatentable over Kleisath 4,705,283 in view of Starratt 1,341,484. The rejection indicates that Kleisath discloses the major parts of the invention, but does not disclose the handle/spacer including the two parallel spaced apart arms. Starratt discloses a handle having the pair of parallel spaced apart arms, and it would have been obvious to one of ordinary skill in the art at the time to have modified the handle of Kleisath to include the parallel arm elements. Interestingly, the reasoning behind the combination of Kleisath and Starratt to reject the claims is not to provide the balance or stability or functionality of Kleisath as balanced on the step of a ladder, but to add strength to the Kleisath handle. *Starratt does not teach balancing its handle on a surface.* Obviously, Starratt does not provide motivation to modify Kleisath so as to perform the function of balancing the handle on a surface or to provide the function of projecting the reel of wire out from the ladder. Making the Kleisath handle stronger does not suggest or make obvious the invention disclosed herein by applicant.

By contrast, claim 1, and all of its dependent claims, are limited to: 1) the spacer configured to extend across and of a breadth to non-rotatably rest on the step of the ladder, and 2) the side rail engaging means, such as the support bar 23, being of a length greater than the space between the side rails of the ladder extending from the spacer, for engaging the first surface of each of the side rails of the ladder above the step engaged by the spacer. The claim goes on to state that the elongated support structure, such as the base leg 24 and opposed parallel legs 16 and 17, being of a length substantially the same as and extending parallel to the length of said side rail

engaging means for supporting work implements, such as the reels 7 mounted on the spool support rod 18. The claim further states that the spacer is of a breadth extending along the step of the ladder on which it rests sufficient to non-rotatably secure the support attachment to the step of the ladder.

The references cited do not suggest this. Kleisath discloses an electrician's wire spool carrier with wheels 12 that apparently are to roll on the ground or on the floor surface of the building structure in which the device is to be used. A handle 8 having handlebars 9 and 11 are used to roll the device, much like a wheelbarrow, about the vicinity where the device is to be used. A peg 15 supports the weight of the frame when it is lowered, as shown in Fig. 3, to prevent the handle 8 from buckling under the load at the point where it connects to the crossbar 7. (Column 2, lines 27-30 of Kleisath.)

One can speculate that if the purpose of Kleisath's peg is to prevent the handle 8 from buckling under the load at the point where it connects to crossbar 7, the same handle would not support the device extending out from a ladder. Indeed, should the Kleisath device be suspended somehow on a step ladder, the full weight of the reel, etc. would no longer be supported by the wheels 12, so the load would be even increased on the handle 8, increasing the hazard of buckling.

From the foregoing, it can be seen that it is extremely unlikely that Kleisath could function to suspend itself by its handle 8. Indeed, the use of a support peg 15 for accommodating the weak handle teaches the use of a weak handle and teaches away from supporting such a

device by its handle on a ladder. And Starratt does not teach suspending itself from a ladder or balancing by its handle on anything.

The handle 1 of Starratt is formed of a single piece of metal and is bent into the form illustrated, and is twisted at 4 and has a tendency to divide along the length of the handle so as to require a keeper 5 (Column 1, lines 37-54). This does not indicate that it could be used to modify Kleisath for balancing Kleisath.

It should be noted that neither Kleisath nor Starratt disclose the concept of supporting a work implement on a ladder, or spools of wire from a ladder. With such weak, narrow handles, it appears that neither would be able to support such a load from a ladder and that neither was ever intended to be supported in a balanced cantilever arrangement by its handle.

Kleisath is designed to support a very heavy spool, weighing up to 800 lbs. or more when full. (Column 1, lines 10-15.) The Kleisath spool carrier is constructed so that it can function as a support rack when it comes to rest as shown in Fig. 3, so that the two pegs 13 lift the reel from the ground. Therefore, a ladder is not required to support the handle of Kleisath.

Claim 15 sets forth the support bar extending parallel to the base leg of the U-shaped frame being of a length greater than the space between the side rails of the ladder for placement on the other side of the steps of the ladder, and the pair of spacer bars for extending across the step of the ladder and spaced from each other a distance sufficient to balance the U-shaped frame on the ladder when wire is paid out from the spool of wire on the spool support rod. This is not disclosed by the applied references. The handle 8 of Kleisath is not likely to be strong enough to support the weight of the spools and wire, etc. If Kleisath should survive being mounted on a

ladder, it is not understood how Kleisath could avoid tilting of the spool carrier, particularly if a spool were moved closer to one or the other of the support members 6, as when several spools are being used. But, there is no disclosure in either Starratt or Kleisath of a ladder-mounted spool support, and no support for balancing Kleisath by its handle.

Claims 9 and 11-14 were rejected under § 103(a) as being unpatentable over Knight, et al. 4,533,091 in view of Kleisath in view of Starratt as applied to claims 1-5, 7, 8, and 15-22, and further in view of Peterson 4,869,344. Knight, et al. is used to teach positioning a wire caddy on the side rails of a ladder. However, Knight, et al. must rigidly mount the brackets of Figs. 3 and 4 to the ladder, on the back of the ladder, not on the steps at the front of the ladder. Once the brackets have been installed, the tubular shaft can be suspended between the brackets and wire spools mounted on the tubular shaft. Peterson also is connected by various brackets (Figs. 1, 5 and 7) to the back of a ladder.

However, Knight, et al. and Peterson do not support their products from a step of a ladder. They must be attached and detached piecemeal from the back of the ladder, as opposed to being completely removable from the ladder as shown in Fig. 2 of applicant's drawing. Indeed Knight, et al. does not even disclose a *wire caddy*, but an assembly that can be mounted piecemeal to the back of a ladder.

Kleisath and Starratt are used to disclose a shape that is more compatible with a ladder. However, as recited above, neither Kleisath nor Starratt suggest that they should be, or even could be, mounted to a ladder because of their physical inabilities. Kleisath discloses a handle that requires a peg to prevent the handle from buckling under the load, and Starratt discloses a handle

that comes apart and must be clamped together by a keeper, which bears no similarity to mounting that device on a ladder. Indeed, Starratt discloses a mulsh layer that is rolled along the ground to lay a strip of paper or other similar material to a row of sugar cane. It does not teach balancing on the handle. This is not analogous prior art.

Response to Cited Case Law

The Office Action cites *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCA 1963). These cases are cited to support the concept of a claim recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant contends that the cited prior art is not capable of performing the intended use. Specifically, Kleisath is defective in that its handle 8 is so weak that it requires a peg to avoid buckling under the load at the point where it connects to the crossbar. Therefore, suspending the Kleisath spool carrier in a cantilever fashion as disclosed by applicant surely would result in a heavier load on the handle, and without the assistance of the peg 15 to avoid buckling. Obviously, the handle of Kleisath was never intended to support the reel that it carries in a cantilever fashion. The secondary reference, Starratt, discloses a narrow handle and does not teach balancing the handle on a surface, and therefore cannot be properly used to modify Kleisath.

Further, the claims of the applicant now more particularly describe the spacer that is configured to extend across the step of the ladder and configured to non-rotatably rest on the step of the ladder. This is not disclosed in the applied references.

Thus, it can be seen that there is structure in the claims that distinguish over the prior art and the combined prior art does not teach the function of applicant's invention.

An argument is made in the Office Action that Kleisath is adapted to be supported by a ladder in the manner described by applicant. However, as stated above, Kleisath appears to teach just the opposite, of requiring a peg 15 to support the handle, when the handle is simply resting on the ground. Thus, Kleisath cannot be equated to a device having spacers that are spread apart for the purpose of non-rotatably supporting the applicant's apparatus on the step of a ladder.

The case of *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992) was cited to support the concept that obviousness can only be established by combining or modifying the teachings of prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. However, the above noted language was used by the court to *reverse* the Board of Appeals.

The Jones Court also stated that:

Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed (invention). -- In the case before us, there must be adequate support in the prior art for the [prior art] Esther/[claimed] --in order to complete the PTO's *prima facie* case and shift the burden of going forward to the applicant. --The prior art must provide one of ordinary skill in the art the

motivation to make the proposed molecular modifications needed to arrive at the claimed compound.

Instead, the Examiner relies on hindsight in reaching his obviousness determination. But this Court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references erect or convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. (Citing *W. L. Gore* 220 USPQ 312-313.) It is essential that "the decisionmaker" forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time when the invention was made...to occupy the mind of one skilled in the art who is presented with only the references, and who is normally guided by the then-accepted wisdom in the art.

One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.

Applicant submits that choosing the handle of a mulsh layer (Starrett) to combine with a spool carrier mounted on wheels like a wheel barrow with a weak handle (Kleisath) so that the combined structure can hang by its handle from a ladder is hindsight reconstruction.

Other hindsight decisions are:

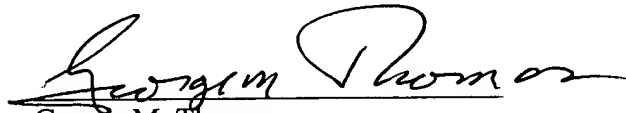
Prior art may not be gathered with the claimed invention in mind. *Kentec v. Graphic Controls Corp.*, 227 USPQ 766, 768-9 (Fed. Cir. 1985).

This Court has made it clear, moreover, that an invention will not be denied a patent because it embodies a solution which seems simple and obvious with the benefit of hindsight. *Saf-gard Products, Inc. v. Service Parts, Inc.*, 190 USPQ 455 (9th Circuit, 1976, *cert. denied*, 429 US 896).

Applicant submits that the claims of the application, as amended, adequately distinguish over the applied prior art. Accordingly, favorable reconsideration of the application is

courteously solicited. In the event that the claims of the application are not ready for allowance, the Examiner is requested to call the undersigned attorney at 770-933-9500 for a discussion of the claim language and the prior art, in an effort to work out language satisfactory to the Examiner.

Respectfully submitted,


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